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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,408	10/02/2006	Robert Pickup	127542	2964
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EXAMINER				
KRISHNAN, VIVEK V				
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2445				
MAIL DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/573,408

**Applicant(s)**

PICKUP, ROBERT

**Examiner**

VIVEK KRISHNAN

**Art Unit**

2445

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3.5-12 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3.5-12 and 14-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is responsive to the Amendment/Arguments filed on August 6, 2008. Claims 3, 5-12, and 14-20 are pending.

#### ***Response to Arguments***

1. Applicant's arguments with respect to Claim Rejections under 35 U.S.C. 112 have been fully considered and are persuasive. The rejections of Claims 1-3 and 5-7 have been withdrawn.
2. Applicant's arguments with respect to Claim Objections due to informalities have been fully considered and are persuasive. The objections to Claims 3 and 9 have been withdrawn.
3. Applicant's arguments with respect to Claim Rejections under 35 U.S.C. 103 have been fully considered but they are not persuasive.
  - a. "Furthermore, the ID in Delany is not unique to each email or email delivery. Each domain Key Selector is used for multiple emails. Additionally, in Delany, a hostname is not created and stored at the Domain Name Server for each email or email delivery. In fact, the Public Key must be previously stored at an existing hostname at the Domain Name Server. Finally, Delany requires data processing at the recipient mail server in order to validate emails. In the presently claimed combination of features, however, no processing needs to be carried out. Further with respect to the presently claimed combination of features, if the hostname can be resolved at the domain name server, the

email is validated. Thus, Delany neither discloses nor renders obvious... [limitations of Claim 3]."

The digital signature, or unique ID, in Delany is based on the header lines, separating lines, content lines, and termination characters of the email message (Delany; column 5 lines 28-67), and hence is unique to the email message.

Wikipedia defines hostname as specific to a host and not as stored uniquely in reference to any particular email message. Hence, a unique hostname is interpreted in terms of each email message having a single hostname associated with it, as taught by Delaney. The hostname is stored along with the public key as a text record and is resolved in order to retrieve the public key which is used to verify the email.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 5-7, 11, 12, 14-16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,986,049 to Delany.

6. Regarding Claims 3 and 12, Delany discloses a method and a system (herein referenced as a method) for delivering electronic messages from a sender to a recipient over a communications network, the method including:

generating a unique identifier for the electronic message (Delany; column 5 lines 27-67 and column 6 lines 1-20, discloses generating a digital signature for the email message);

storing a unique hostname based upon this unique identifier on a domain name server (Delany; column 5 lines 27-67 and column 6 lines 1-20, discloses storing a text record including a hostname on a domain name server based on the digital signature/key pair for email transmission authorization);

Delany does not explicitly disclose for the delivery of each electronic message from the sender to the recipient, receiving a delivery request from a sender mail server, the delivery request including a recipient email address and a sender identification.

However, Delany delegates the responsibility of generating a unique identifier for the email message and storing a hostname on a domain name server based on the unique identifier directly to the sender mail server. The sender mail server, as disclosed by Delany, performs the steps of generating a unique identifier and storing a hostname on a domain name server when transmitting the email. Hence, the step of receiving a delivery request from a sender mail server is integrated into the functionality of the prior art sender mail server, as disclosed by Delany.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify a sender mail server generating a unique identifier for the email message and storing a hostname on a domain name server based on the unique identifier, as disclosed by Delany, such that the functionality of generating a unique identifier and storing a hostname on a

domain name server is delegated to a separate server which performs its functionality in response to communication with the sender mail server .

One of ordinary skill in the art at the time the invention was made would have been motivated to make this modification since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlicnman*, 168 USPQ 177, 179.

Delany discloses verifying authorization of the email message, wherein verifying authorization of the email message includes the extraction of the unique identifier from the email message at the recipient mail server and resolving the unique hostname based upon the unique identifier at the domain name server (Delany; column 6 lines 20-67 and column 7 lines 1-2, discloses verifying authorization of an email message by using the digital signature included the email message transmission to query a domain name server and resolving the hostname as a text record at the domain name server);

Delany does not explicitly disclose receiving an email message verification request from a recipient mail server; and transmitting a verification result to the recipient mail server upon resolving the hostname.

However, Delany delegates the responsibility of verifying the authorization of the email message directly to the recipient mail server. The recipient mail server, as disclosed by Delany, performs the step of verification in response to receiving an email message instead of making a request to another server to verify the email message. Hence, the steps of receiving an email message verification request from a recipient mail server, and transmitting a verification result to

the recipient mail server upon resolving the hostname are integrated into the functionality of the prior art recipient mail server, as disclosed by Delany.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify a recipient mail server verifying the authorization of an email message, as disclosed by Delany, such that the functionality of verifying the authorization of an email message is delegated to a separate server and the recipient mail server determines the authorization of the email message through communication with the separate server.

One of ordinary skill in the art at the time the invention was made would have been motivated to make this modification since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlicnran*, 168 USPQ 177, 179.

7. Regarding Claims 5 and 14, Delany, as modified, discloses each and every limitation of Claim 3 and 12. Delany further discloses wherein the verification result allows transmission of the email where first and second component values of the resolved hostname match with encoded values of the sender and recipient addresses respectively (Delany; column 6 lines 20-67 and column 7 lines 1-2, discloses allowing the email transmission when the components of the header, as determined from the resolved digital signature, match the values of the sender and recipient addresses).

8. Regarding Claims 6 and 15, Delany, as modified, discloses each and every limitation of Claims 3 and 12. Delany further discloses wherein the verification result allows transmission of

the email where the value of only a first component of the resolved hostname matches an encoded value of the sender address (Delany; column 6 lines 20-67 and column 7 lines 1-2, discloses allowing the email transmission when a component of the header, as determined from the resolved digital signature, matches the value of the sender address).

9. Regarding Claims 7 and 16, Delany, as modified, discloses each and every limitation of Claims 3 and 12. Delany further discloses wherein the verification result disallows transmission of the email where the hostname is not found in the domain name server, where first or second components of the resolved hostname do not match encoded values of the sender or recipient addresses respectively, or where the first component value of the resolved hostname does not match the encoded value of the sender address (Delany; column 6 lines 20-67 and column 7 lines 1-2, discloses disallowing the email transmission when the text record including the hostname does not exist, or when components of the header, as determined from the resolved digital signature, do not match the values of the sender or recipient addresses).

10. Regarding Claims 11 and 20, Delany, as modified, discloses each and every limitation of Claims 3 and 12. Delany further discloses wherein the delivery request includes an identification of a sender email address and a recipient email address (Delany; column 5 lines 27-67 and column 6 lines 1-20, discloses generating a digital signature for the email message using the sender and recipient email address).



11. Claims 8-10, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delany as applied to Claims 3 and 12 above, and further in view of U.S. Patent No. 7,219,131 to Banister et al. (hereinafter 'Banister').

12. Regarding Claims 8 and 17, Delany, as modified, discloses each and every limitation of Claims 3 and 12. Delany does not explicitly disclose, but Banister discloses adding the sender to a list of allowed senders (Banister; column 1 lines 60-67 and column 2 lines 1-6, discloses the use of white-lists in filtering emails).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify authorizing emails, as disclosed by Delany, to include adding a sender to a white list, as disclosed by Banister.

One of ordinary skill in the art at the time the invention was made would have been motivated to make this modification in order to filter emails more accurately and effectively.

13. Regarding Claims 9 and 18, Delany, as modified, discloses each and every limitation of Claims 3 and 12. Delany further discloses providing the recipient control options for future correspondence received from the sender (Banister; column 1 lines 60-67 and column 2 lines 1-6, discloses providing the recipient the ability to place the sender in white-lists or black-lists).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify authorizing emails, as disclosed by Delany, to include providing the recipient the ability to place the sender in white-lists or black-lists and thereby control future correspondence received from a sender, as disclosed by Banister.

One of ordinary skill in the art at the time the invention was made would have been motivated to make this modification in order to filter emails more accurately and effectively.

14. Regarding Claims 10 and 19, Delany, as modified, discloses each and every limitation of Claims 3 and 12. Delany does not explicitly disclose, but Banister discloses generating a database query to determine whether the recipient has opted out of receiving communications from the sender (Banister; column 1 lines 60-67 and column 2 lines 1-6, discloses the use of black-lists in filtering emails).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify authorizing emails, as disclosed by Delany, to include using a black list to determine whether a recipient has prohibited messages from a sender, as disclosed by Banister.

One of ordinary skill in the art at the time the invention was made would have been motivated to make this modification in order to filter emails more accurately and effectively.

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VIVEK KRISHNAN whose telephone number is (571) 270-5009. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VK

/Jason D Cardone/  
Supervisory Patent Examiner, Art Unit 2445